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EXAMINER
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YOUNG, MICAH PAUL

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 06/24/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/060,060

Applicant(s)

ROLF ET AL.

Examiner

Micah-Paul Young

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-60,62,64-102 and 106-120 is/are pending in the application.
- 4a) Of the above claim(s) 2,5,10,11,13,14,17-20,30,64-71,102 and 118-120 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,6-9,12,15-16,21-60,62,72-101,106-117 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

**Acknowledgment of Papers Received:** Amendment and Response to Election/Restriction

Requirement dated 3/10/03.

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1 – 63, 72 – 101, and 106 -108, drawn to an adhesive patch comprising a backing, cosmetic agent, solvent, a permeation enhancer and a polymer, classified in class 424, subclass 448.
  - II. Claims 64 – 71, drawn to an adhesive patch comprising a backing, cosmetic agent, solvent, permeation enhancer, polymer and sizing agent, classified in class 424, subclass 448.
  - III. Claims 102, and 109 – 111 drawn to adhesive mask comprising a two part system comprising a backing and a cosmetic formulation comprising a solvent, permeation enhancer, cosmetic agent, and pressure sensitive adhesive, classified in class 424, subclass 448.
  - IV. Claims 103, and 112 – 114 drawn to an adhesive mask comprising a two part system comprising a backing and a cosmetic formulation comprising a solvent, permeation enhancer, cosmetic agent, and pressure sensitive adhesive, classified in class 424, subclass 448.
  - V. Claim 104, and 115 – 117 drawn to adhesive mask comprising a two part system comprising a backing and a cosmetic formulation comprising a solvent,

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permeation enhancer, cosmetic agent, and pressure sensitive adhesive, classified in class 424, subclass 448.

- VI. Claims 105 drawn to an adhesive mask comprising a two part system comprising a backing and a cosmetic formulation comprising a solvent, permeation enhancer, cosmetic agent, and pressure sensitive adhesive, classified in class 424, subclass 448.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions I and II both recite adhesive patch formulations comprising solvents, cosmetic agents and a backing, yet group II recites the inclusion of a sizing agent, which is not required by the formulation of group I. These two inventions are structurally different because of this and can encompass different utilities.
3. Inventions I, II and III – VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of groups I and II differ drastically from the remaining groups. I and II are drawn to adhesive patches, themselves distinct from each other, while the remaining groups III – VI are drawn to adhesive facial masks. The adhesive patch formulation of groups I and II do not have to be fashioned in to masks as described by groups II – VI. The patches can be fashioned

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into many various transdermal delivery systems for various parts of the body. The adhesive patches could also be fashioned or constructed for trans-mucosal delivery as well.

4. Inventions III and IV – VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of groups IV – VI are unrelated since the invention of group III. Group III is drawn to an adhesive mask comprising any cosmetic product, while groups IV and V are drawn to specific product, which change the structure, function and utility of the respective masks. Group III differs from VI in that the mask of VI required that the mask be contoured to the face of the individual, while the mask of III is silent to the contouring, and only requires apertures for the eyes and nose. The mask of group III can operate without the contouring required by group VI and therefore structurally a different product.

5. Inventions IV and V – VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of groups IV and V are unrelated in that they recite different cosmetic agents which all possess different properties. These agents change the function and structure of the masks and therefore produce structurally different products. The invention of group IV is also unrelated to that of VI in that the mask of VI requires the mask to be contoured while IV is silent to this. The mask of group IV can operate without the mask being contoured and provides a

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structurally different product. Also groups V and VI are unrelated and different for the same reasons as IV and VI are unrelated.

6. This application contains claims directed to the following patentably distinct species of the claimed invention: *backing polymer*:

- a. Poly-cellulose fibers
- b. Polyester fibers
- c. Polyurethane fibers
- d. Polyolefin fibers
- e. Polyamide fibers
- f. Cotton fibers
- g. Polyurethane
- h. Polyvinyl chloride
- i. Polyethylene
- j. Co-polyester fibers.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 reciting baking polymer is generic.

This application contains claims directed to the following patentably distinct species of the claimed invention: *cosmetic agent*:

- a. Lycopene
- b. Tumeric
- c. Green and white tea

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- d. An alpha or beta hydroxyl acid
- e. Vitamins C, E and A
- f. Collagen synthesis stimulator
- g. Fibroblast growth stimulator
- h. Collagen cross-linking inhibitor
- i. Tourmaline
- j. Caffeine
- k. Theophylline

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 reciting a cosmetic agent is generic.

This application contains claims directed to the following patentably distinct species of the claimed invention: *solvent*:

- a. Polyhydric alcohol
- b. Triacetin
- c. 1,3-propane diol, 2-methyl-1,3-propane diol, glycerol ricinoleate
- d. PEG-6 caprylic / capric glycerides, capric triglycerides, propylene glycol dicaprylate / dicaprinate
- e. Glycerol monostearate, monocaprylate, monolaurate
- f. Cholesterol NF, diethylene glycol ethyl ether and acetate
- g. Deoxycholic acid, taurodeoxycholic acid, 3-[(3-cholamidopropyl) dimethylammonio]-1-propane-sulfonate, BigCHAP, cholic acid

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Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 reciting a solvent agent is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claims, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Claims 2, 4, 5, 10-14, 30, and 17-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6.

Claims 61, 63, 103-105 have been canceled.



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Applicant has elected without traverse newly regrouped group I: 1-63, 72-101, and 106-117.

The pending claims are: 1, 3, 6-9, 15, 16, 21-29, 31-60, 62, 72-101, and 106-117.

### ***Double Patenting***

1. Claim 60 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 3.

When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

2. Claims 91 and 92 are objected to under 37 CFR 1.75 as being a substantial duplicate of claim 76 and 75. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 53 and 80 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 53 contains the trademark/trade name Jergens, Vaseline Intensive Care, Nivea Lotion, and Ivory Soap. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe lotion or ointment scents and, accordingly, the identification/description is indefinite.

3. Claim 80 recites the limitation "wherein the filler is malto dextrin" in line 1 of the claim. There is insufficient antecedent basis for this limitation in the claim. The claim is dependent from claim 76 yet claim 76 does not recite the inclusion of a filler material.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 6-8, 26, 27, 32 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Katz et al (USPN 5,028,435). The claims are drawn to an adhesive transdermal patch

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comprising a flexible backing material, a cosmetic agent, a solvent, a skin absorption enhancer a pressure sensitive adhesive and a polymer.

Katz discloses a transdermal patch comprising a flexible backing material (polyurethane, etc. col. 4, lin. 15 – 22), vitamins (col. 5, lin. 50 – 55), propylene glycol (col. 6, lin. 1), absorption enhancers (col. 5, lin. 55 – 67), polymers and solvents. These disclosures along with others render the claims anticipated.

3. Claims 1, 6-9,15,16,24, 26, 27, 32, 39, 40, 44, 45, 49, 50, 72, 73, 79, 85, 86, 88, 89, 97, 98, 100, 101, 106, 107, 112, 113, 115 and 116 are rejected under 35 U.S.C. 102(b) as being anticipated by Porter et al (USPN). The claims are drawn to a transdermal patch comprising a pressure sensitive adhesive matrix, a solvent, a penetration enhancer, and a cosmetic agent. The cosmetic agent is recited to be a vitamin (C, A, or E). The claims also recite that the polymeric matrix, along with its constituents are located on the entire front side of the baking layer, or are embedded in the backing layer. The device also comprises a preservative such as propylene glycol. Claims 106, 107, 112, 113, 115 and 116 are drawn to methods of treating the skin with transdermal patches of claim 1.

Porter et al discloses a pressure sensitive adhesive patch with a flexible backing and release liner that comprises solvents, penetration enhancers, and vitamins (C, A, and E) (Abstract; col. 4, lin. 10 – 58; col. 5, lin. 9 – 35; examples). The device is used on the skin to reduce wrinkles, and further treat and condition the skin. The matrix is located on the entire front side of the baking layer (Figures). These disclosures along with others render the claims anticipated.

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4. Claims 1, 3, 35, 39, 40, 44, 45, 49 – 51, and 58-60 are rejected under 35 U.S.C. 102(b) as being anticipated by Chiang et al (USPN 5,252,334). The claims are drawn to a pressure sensitive adhesive comprising a solvent, penetration enhancers, cosmetic agents, a flexible backing and fragrance.

Chiang et al discloses pressure sensitive adhesive transdermal device comprising solvents, permeation enhancers, acrylic copolymers, dermatological agents, and fragrances (Abstract; col. 4, lin. 1 – col. 6, lin. 60). The backing is a flexible material such as polyester, which can be either water insoluble or soluble. These disclosures along with others render the claims anticipated.

5. Claims 1, 3, 58-60, 82 and 83 rejected under 35 U.S.C. 102(b) as being anticipated by Sharma et al (USPN 5,229,130). The claims are drawn to a transdermal device comprising a flexible backing and a penetration enhancer. The penetration enhancer is recited to be diethylene glycol monoethyl ether.

Sharma et al discloses a transdermal pressure sensitive adhesive comprising solvents, polymers, a flexible backing made from polyester and a penetration enhancer (col. 3, lin. 65 – col. 4, lin. 38). The penetration enhancer is disclosed as diethylene glycol monoethyl ether (col. 5, lin. 5 – col. 6, lin. 40). These disclosures along with others render the claims anticipated.

6. Claims 1, 3, 7-9, 41-42, 58-60, 85 and 86 are rejected under 35 U.S.C. 102(b) as being anticipated by Cilento et al (USPN 5,059,189). The claims are drawn to an adhesive patch comprising a flexible backing, solvent, polymers, and an emulsifier, pectin.

Cilento et al discloses an adhesive patch comprising a pressure sensitive adhesive matrix, a flexible backing, and antioxidants as active agents. The device also comprises pectin in the

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matrix and polyester fibers in the backing material (col. 3, lin. 54 – co. 7, lin. 26). These disclosures along with others render the claims anticipated.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 21-23, 29, 31, 36-38, 46-48, 62, 74, 81, 84, 90, 99, 108, 109 – 111, 114, and 117 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porter et al (USPN 5,785,978).

The claims are drawn to an adhesive patch comprising a cosmetic agent, solvent, polymers, optional skin conditioners, protectants and preservatives. Claims 108, 111, 114, and 117 are drawn to a method of using the adhesive patch where the patch is applied for 24 hours during the skin treatment.

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As discussed above in the *102* discussions, Porter discloses a pressure sensitive adhesive patch comprising cosmetic agents, solvents, polymers skin conditioners, protectants and preservatives. What is lacking from the reference are the particular concentrations of each component present in the invention. Porter however presents the general combination of these essential and nonessential components. It has been held that, where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *See In re Aller*, 220 F.2d 454 105 USPQ 233, 235 (CCPA 1955).

Furthermore the claims differ from the reference by reciting various concentrations of the active ingredient(s). However, the preparation of various cosmetic compositions having various amounts of the active is within the level of skill of one having ordinary skill in the art at the time of the invention. It has also been held that the mere selection of proportions and ranges is not patentable absent a showing of criticality. *See In re Russell*, 439 F.2d 1228 169 USPQ 426 (CCPA 1971).

With this in mind it would have been obvious to a skilled artisan to follow the teachings and suggestions of Porter in order to achieve the maximum result. A skilled artisan would have been able to optimize the essential components through routine experimentation, and done this in order to deliver the cosmetic agents most effectively. A skilled artisan would have been able to cater the resultant optimized adhesive patch to whatever application regimen would best fit the user. A skilled artisan would have been able to modify the thickness of the backing, polymer matrix, and release liner as well. A skilled artisan would also be able to load as many adhesive patches onto a release liner as possible, in order to produce mass quantities. The mass

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production of the adhesive patches is well within the level of skill in the art. Whether 24 hours or more, it would have been well within the level of skill in the art to apply the adhesive patch to the skin to achieve a desired affect (exfoliation, wrinkle removal, or tightening). The result would be dependent upon the cosmetic agent and this as could have been determined through routine experimentation. It would have been obvious to a skilled artisan to follow these teachings and suggestion, and also optimize them, with an expected result of an adhesive patch useful for removing wrinkles, and otherwise caring for human skin.

10. Claim 21-23, 31, 43, and 56 – 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cilento et al (USPN 5,059,189) in view of Berry et al (USPN 4,784,857). The claims are drawn to an adhesive patch comprising various concentrations of solvent and an emulsifier. The claims also recite that the backing is made from polyester fibers.

As discussed above Cilento discloses many essential elements of the claimed invention. The reference lacks the concentrations of cosmetic agents and emulsifiers such as pectin as recited by the applicant. The reference discloses the general combination of cosmetic agents in a pressure sensitive adhesive delivery system. It has been held that, where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *See In re Aller*, 220 F.2d 454 105 USPQ 233, 235 (CCPA 1955).

Furthermore the claims differ from the reference by reciting various concentrations of the active ingredient(s). However, the preparation of various cosmetic compositions having various amounts of the active is within the level of skill of one having ordinary skill in the art at the time of the invention. It has also been held that the mere selection of proportions and ranges is not

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patentable absent a showing of criticality. *See In re Russell*, 439 F.2d 1228 169 USPQ 426 (CCPA 1971).

With regard to claims 56 – 59, which recite limitations to the backing material of the device, Cilento is also lacking explicit disclosures to the permeability of the backing. Cilento discloses polyester being used as a flexible material yet does not disclose the permeability of said backing. Berry et al discloses a pressure sensitive adhesive delivery device where the polymeric matrix comprises vitamins (col. 2, lin. 24 – 43). The device comprises a flexible backing containing polyester fiber (examples). The can include micro-pores, and be moisture vapor permeable (col. 3, lin. 64 – col. 4, lin. 10). Since the backing is made from polyester it can either be, water impermeable or permeable depending on the process by which the polyester fiber is prepared, all of which can be determined by an artisan of ordinary skill. A skilled artisan would have used the backing of Berry with the device of Cilento in order to produce a better device that contoured to the wearer's body.

With this in mind a skilled artisan would have been motivated to combine the suggestions and teachings of the art. A skilled artisan would have been motivated to modify the concentrations of both Berry and Cilento in order to maximize the effectiveness of the device. A skilled artisan would have been motivated to use the backing material of Berry with the device of Cilento in order to produce a better device that contoured to the wearer's body. It would have been obvious to a skilled artisan would make these modifications and combinations with an expected result of a transdermal device that would contour to the body and allow for moisture to permeate to the skin. This device would be useful in the cosmetic treatment and maintenance of the skin.



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11. Claims 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chiang et al (USPN 5,252,334). The claims are drawn to an adhesive patch comprising a flexible backing and a pressure sensitive adhesive matrix comprising acrylic copolymers in specific concentrations.

As discussed above, Chiang et al discloses an adhesive patch where the matrix comprises acrylic polymers (col. 4, lin. 1 – 37). The reference however lacks the specific concentrations of the acrylic copolymers recited by the invention. These concentrations however are well within the level of ordinary skill in the art. The reference presents the general disclosure of acrylic copolymers in an adhesive pressure sensitive matrix.

It has been held that, where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *See In re Aller*, 220 F.2d 454 105 USPQ 233, 235 (CCPA 1955).

Furthermore, the claims differ from the reference by reciting various concentrations of the active ingredient(s). However, the preparation of various cosmetic compositions having various amounts of the active is within the level of skill of one having ordinary skill in the art at the time of the invention. It has also been held that the mere selection of proportions and ranges is not patentable absent a showing of criticality. *See In re Russell*, 439 F.2d 1228 169 USPQ 426 (CCPA 1971).

With this in mind, it would have been obvious to a skilled artisan to follow the suggestions and teachings of the art. A skilled artisan would have been motivated to modify and optimize the acrylic copolymer concentrations in order to optimize the delivery of the cosmetic and dermatological agents in the adhesive patch. It would have been obvious to a skilled artisan

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to optimize these concentrations with an expected result of an adhesive patch comprising an acrylic matrix with improved delivery of cosmetic agents.

12. Claims 51-53, 75-81, and 91 – 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porter et al (USPN 5,785,978) in view of Smith et al (USPN 5,460,620) in further view of Crotty et al (USPN 6,106,857) and Mitra et al (USPN 5,890,486). The claims are drawn to an adhesive patch comprising a flexible backing, a penetration enhancer, cosmetic agents and other optional dermatological agents.

As discussed above Porter discloses many of the essential elements of the invention. What is lacking is a disclosure of a keratolytic agent. Smith discloses a transdermal device which to the skin dermatological agents (Abstract). The device comprises a flexible backing, and the matrix comprises resorcinol as a keratolytic agent (examples). A skilled artisan would have been motivated to include the keratolytic agent of Smith into Porter in order to improve the health of the applied skin.

With regard to claims 51-53, Smith also suggests the inclusion of fragrances into the device. Smith suggests the inclusion as an optional addition along with lotions, ointments and other helpful components. Smith however does not disclose a particular fragrance, though choosing one would be well within the level of ordinary skill in the art. This is seen in Crotty et al. Crotty et al discloses a pressure sensitive adhesive patch used to remove keratoic plugs, which comprises fragrances such as musk and vanilla (col. 2, lin. 55 – col. 4, lin. 46). It would have been obvious to a skilled artisan to include a fragrance into the composition in order to provide a pleasant masking effect for the cosmetic agents.

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Smith does not however disclose the concentration of claims 77 and 78. The reference in combination with Porter discloses the general combination of resorcinol with an adhesive patch. It has been held that, where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *See In re Aller*, 220 F.2d 454 105 USPQ 233, 235 (CCPA 1955).

Furthermore the claims differ from the reference by reciting various concentrations of the active ingredient(s). However, the preparation of various cosmetic compositions having various amounts of the active is within the level of skill of one having ordinary skill in the art at the time of the invention. It has also been held that the mere selection of proportions and ranges is not patentable absent a showing of criticality. *See In re Russell*, 439 F.2d 1228 169 USPQ 426 (CCPA 1971).

With regard to claims 79-81, Smith also suggest the inclusion of inert fillers such as dextrin, yet does not disclose malto dextrin or a concentration for such fillers. Mitra et al disclose fillers such as malto-dextrin used in transdermal deliver patches with adhesive matrices (col. 9, lin. 34 – col. 10, lin. 11). The reference lacks the concentrations as recited in claim 81, but as previously discussed these concentrations can be determined through routine experimentation, which is within the level of ordinary skill in the art.

With this in mind a skilled artisan would have been motivated to combine the teachings and suggestions of the art. A skilled artisan would have been motivated to combine the keratolytic compound of Smith into the device of Porter, in order to deliver an increased dermatological effect to the application situs. A skilled artisan would have also been motivated to optimize the concentration of the keratolytic agent in order to deliver the maximum and most

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effective dosage. A skilled artisan would have also been motivated to include one of the many fragrances from Crotty in order to mask the smell of the cosmetic agents. It would have been obvious to a skilled artisan to combine these teachings with an expected result of an adhesive device with increase dermatological effect on the application situs and a pleasant smell.

13. Claims 94-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porter et al (USPN 5,785,978) in view of Torgerson et al (USPN 5,730,966). The claims are drawn to an adhesive device comprising and flexible backing and a polymeric matrix. The polymeric matrix comprises an astringent such as alum.

As discussed above Porter discloses many essential elements of the claimed invention. What is lacking in the reference is a disclosure of an astringent in the formulation. The reference discloses the inclusion of various beneficial cosmetic and dermatological agents, yet does not name an astringent.

Torgerson et al discloses a transdermal preparation for cosmetic use, specifically the treatment of hair and skin, comprising a polymeric matrix. The polymeric matrix further comprises the astringent witch hazel (col. 23, lin. 24 – col. 24, lin. 40; examples). A skilled artisan would have been motivated to include the astringent of Torgerson in order to minimize the pores of the skin.

With regard to claim 96 and the concentration of the astringent, it would have been obvious to optimize the concentrations of the reference. It is well within the level of ordinary skill in the art to determine specific concentration through routine experimentation. It has been held that, where the general conditions of a claim are disclosed in the prior art, it is not inventive

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to discover the optimum or workable ranges by routine experimentation. *See In re Aller*, 220 F.2d 454 105 USPQ 233, 235 (CCPA 1955).

Furthermore the claims differ from the reference by reciting various concentrations of the active ingredient(s). However, the preparation of various cosmetic compositions having various amounts of the active is within the level of skill of one having ordinary skill in the art at the time of the invention. It has also been held that the mere selection of proportions and ranges is not patentable absent a showing of criticality. *See In re Russell*, 439 F.2d 1228 169 USPQ 426 (CCPA 1971).

With this in mind it would have been obvious to a skilled artisan include the astringent of Torgerson into the formulation of Porter in order to better condition and treat the skin. The inclusion of an astringent would help to keep pores clear once they have been cleansed, moisturized and treated. Porter suggests the inclusion of skin conditioners and this would have been obvious to one of ordinary skill. It also would have been obvious to modify and optimize the concentration of the astringent in order to maximize its effectiveness. It would have been obvious to one of ordinary skill in the art to combine these teachings and suggestions with an expected result of an adhesive patch that was effective in keeping pore closed so as to prevent dirt build-up.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Micah-Paul Young whose telephone number is 703-308-7005. The examiner can normally be reached on M-F 7:30am - 4:30pm.

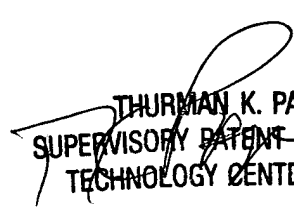
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7648 for regular communications and 703-746-7648 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

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Examiner  
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